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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,638	11/24/2003	Nareak Douk	P1714	1187
28390 7590 09/18/2009 MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403				
EXAMINER KOEHLER, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
3726				
NOTIFICATION DATE		DELIVERY MODE		
09/18/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

Office Action Summary

Application No.

10/718,638

Applicant(s)

DOUK ET AL.

Examiner

Christopher M. Koehler

Art Unit

3726

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/30/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6, 8, 12-17 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 9-11 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. (US Patent No. 6,325,815) in view of Chouinard et al. (US 2002/0007210).

Claims 1 and 20:

Kusleika teaches a method for manufacturing a distal protection element (figure 1) for preventing emboli in a blood vessel from moving away from a treatment site during a vascular procedure (col. 4, lines 25-32), the method comprising braiding a plurality of filaments to form an enclosure (col. 3, line 63-col. 4, line 16); and forming the braided enclosure to have a first end region and a second end region (figure 1), each of

the first and second end regions having a taper region (figure 1) and a neck region (60, 65) adapted for attachment to a guidewire (20, col. 3, lines 17-32). Kusleika does not explicitly teach reducing the thickness of the filaments forming the braided enclosure along at least a portion of the first end region.

Chouinard teaches a vascular device comprised of braided filaments wherein the braided filaments are reduced in diameter along at least a portion of a first end of the device (figure 17; paragraphs [0083] and [0084]). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the reducing teaching in Chouinard in the method of Kusleika in order to provide a smaller diameter section of the filament in a tortuous portion of the stent or in a region requiring greater flexibility (Chouinard, paragraph [0084]).

Kusleika/Chouinard fails to explicitly teach that the reducing the thickness of the filaments takes place after the step of forming the braided enclosure. At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have reduced after braiding the enclosure because applicant has not disclosed that reducing filament thickness after braiding provides an advantage, is used for a particular purpose or solves a stated problem as opposed to reducing filament thickness prior to braiding. One of ordinary skill in the art, furthermore, would have expected applicants invention to perform equally well with either the pre-braiding reduction taught by Chouinard or the claimed post-braiding reduction because either order of steps results in the same structure. Therefore, it would have been an obvious

matter of design choice to modify Kusleika/Chouinard to obtain the invention specified in claims 1 and 20.

Claims 2 and 4:

Kusleika teaches heat treating the filaments of the braided distal protection element after the reducing step (col. 5, lines 4-10).

Claim 5:

Kusleika teaches that the protection element is a capture element (abstract).

Claims 18 and 19:

Kusleika teaches that the filaments comprise metal nitinol tubing wires (col. 4, lines 2-16).

4. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika in view of Chouinard as applied to the claims above, and further in view of Heilman et al. (US Patent No. 4,080,706).

Claims 9-11:

Kusleika/Chouinard teach the structure above but do not explicitly teach the manner in which the filaments are reduced.

Heilman teaches the tapered reduction of an element of a vascular device wherein the taper is formed by electro-etching the portion of the element (col. 6, lines 1-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the reducing teaching of Heilman into the method of Kusleika/Chouinard where they have been silent on the manner of reducing since etching is known in the art to be an effective way of forming tapers in elements of

vascular devices. It should be further noted that the alternatively claimed methods of reducing the filament are known and merely functional equivalents with the etching of Heilman and therefore would also have been obvious to one of ordinary skill in the art.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. As noted above, reducing the thickness of the filaments after the step of forming the braided enclosure is deemed to have been an obvious matter of design choice to a person of ordinary skill in the art,

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571)272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. M. K./
Examiner, Art Unit 3726

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726